

## **REMARKS:**

Claims 1-20 are currently pending in the application. Claims 1 and 11 are currently amended.

Claims 1, 3, 5, 6-9, 11, 13, 15-18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,374,039 to Schmidt et al. ("Schmidt"). Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of U.S. Patent No. 5,535,861 to Young ("Young"). Claims 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of U.S. Patent App. 2006/0162778 to Nichols et al. ("Nichols"). Claims 10 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of U.S. Patent 2,774,553 to Jensen ("Jensen").

## **Rejections Under 35 U.S.C. § 103(a):**

Claims 1, 3, 5, 6-9, 11, 13, 15-18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt. However, as discussed below, this rejection is respectfully traversed.

### **Claims 1, 3, 5, and 6-9**

Claim 1 is an independent claim, and Claims 3, 5, and 6-9 depend, from Claim 1, and intervening claims. Accordingly, the remarks herein made in connection with Claim 1 apply equally to Claims 3, 5, and 6-9.

It is respectfully pointed out that the standards set forth by the MPEP require that all of the limitations of the claim must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be

considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).<sup>1</sup>

As pointed out above, in order for the reference or combination of references to render Claim 1 obvious, the reference(s) must teach or suggest all of the limitations of Claim 1. The Applicants submit that the Office Action fails to articulate how Schmidt discloses or teaches at least several requirements of Claim 1. For example, Claim 1 requires when the flow of fluid through the primary passage is permitted, movement of the piston is resisted by a first spring rate due to a shear force required to cause shear deflection of the seals; and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the seals. The Office Action makes no mention of how Schmidt discloses or teaches these features. Thus, Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness.

Furthermore, the Office Action indicates that Schmidt discloses a selectively switchable valve as element 82. However, element 82 of Schmidt is merely a floating member for a pressure relief valve so as to allow flow in only one direction during pressure relief conditions (Col. 6, ll 35-56). As such, Claim 1 is hereby amended to more particularly point out that when the selectively switchable valve is open, the flow of fluid through the primary passage is not resisted by the selectively switchable valve in either direction; further, when the selectively switchable valve is closed, the flow of fluid through the primary passage is restricted in both directions by the selectively switchable valve.

The Applicants make this amendment to Claim 1 in order to further prosecution, notwithstanding the aforementioned deficiencies of the Office Action. The Applicants submit that Claim 1, and Claims 3, 5, and 6-9 which depend from Claim 1, and intervening claims, are in condition for allowance. The Applicants submit that the remarks and amendments made herein regarding Claim 1 overcome the Examiner's rejections under 35 U.S.C. § 103(a), and that Claim 1, as amended, and Claims 3, 5,

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<sup>1</sup> MPEP § 2143.03.

and 6-9, are now in condition for allowance. Therefore, the Applicants respectfully request that Claims 1, 3, 5, and 6-9 be allowed.

Claims 11, 13, and 15-18

Claim 11 is an independent claim, and Claims 13 and 15-18 depend, from Claim 11, and intervening claims. Accordingly, the remarks herein made in connection with Claim 11 apply equally to Claims 13 and 15-18.

It is respectfully pointed out that the standards set forth by the MPEP require that all of the limitations of the claim must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).<sup>2</sup>

As pointed out above, in order for the reference or combination of references to render Claim 11 obvious, the reference(s) must teach or suggest all of the limitations of Claim 11. The Applicants submit that the Office Action fails to articulate how Schmidt discloses or teaches at least several requirements of Claim 11. For example, Claim 11 requires when the flow of fluid through the primary passage is permitted, movement of the piston is resisted by a first spring rate due to a shear force required to cause shear deflection of the seals; and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the seals. The Office Action makes no mention of how Schmidt discloses or teaches these features. Thus, Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness.

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<sup>2</sup> *Id.*

Furthermore, the Office Action indicates that Schmidt discloses a selectively switchable valve as element 82. However, element 82 of Schmidt is merely a floating member for a pressure relief valve so as to allow flow in only one direction during pressure relief conditions (Col. 6, ll 35-56). As such, Claim 11 is hereby amended to more particularly point out that when the selectively switchable valve is open, the flow of fluid through the primary passage is not resisted by the selectively switchable valve in either direction; further, when the selectively switchable valve is closed, the flow of fluid through the primary passage is restricted in both directions by the selectively switchable valve.

The Applicants make this amendment to Claim 11 in order to further prosecution, notwithstanding the aforementioned deficiencies of the Office Action. The Applicants submit that Claim 11, and Claims 13 and 15-18 which depend from Claim 11, and intervening claims, are in condition for allowance. The Applicants submit that the remarks and amendments made herein regarding Claim 11 overcome the Examiner's rejections under 35 U.S.C. § 103(a), and that Claim 11, as amended, and Claims 13 and 15-18, are now in condition for allowance. Therefore, the Applicants respectfully request that Claims 11, 13 and 15-18 be allowed.

#### Claim 20

It is respectfully pointed out that the standards set forth by the MPEP require that all of the limitations of the claim must be taught or suggested by the prior art in order to establish a *prima facie* case of obviousness:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).<sup>3</sup>

As pointed out above, in order for the reference or combination of references to render Claim 20 obvious, the reference(s) must teach or suggest all of the limitations of

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<sup>3</sup> *Id.*

Claim 20. The Applicants submit that the Office Action fails to articulate how Schmidt discloses or teaches at least several requirements of Claim 20. For example, Claim 20 requires selectively controlling an amount of fluid flow through the passage, such that movement of the piston is resisted by a total spring rate, which is the sum of a first spring rate due to a shear force required to cause shear deflection of the seals and a second spring rate due to a force required to cause bulging deflection of the seals by fluid pressure induced by the movement of the piston. The Office Action makes no mention of how Schmidt discloses or teaches these features. Thus, Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness.

The Applicants submit that the remarks made herein regarding Claim 20 overcome the Examiner's rejection under 35 U.S.C. § 103(a), and that Claim 20 is in condition for allowance. Therefore, the Applicants respectfully request that Claim 20 be allowed.

Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of Young. However, as discussed below, this rejection is respectfully traversed.

#### Claim 2

Claim 2 is dependent upon Claim 1. Accordingly, the remarks herein regarding Claim 1 apply equally to Claim 2. That is, Schmidt cannot render obvious Claim 2 at least for the same reasons that Schmidt cannot render obvious Claim 1. Young fails to cure the deficiencies of Schmidt. Thus, Schmidt and Young, whether considered separately or on combination as proposed by the Office Action, fail to disclose or suggest all of the limitations of Claim 2. In light of these remarks, it is respectfully requested that the rejection of Claim 2 under 35 U.S.C. § 103(a) over Schmidt in view of Young be reconsidered and withdrawn. The Applicants respectfully request that Claim 2 be allowed.

#### Claim 12

Claim 12 is dependent upon Claim 11. Accordingly, the remarks herein regarding Claim 11 apply equally to Claim 12. That is, Schmidt cannot render obvious Claim 12 at least for the same reasons that Schmidt cannot render obvious Claim 11. Young fails to cure the deficiencies of Schmidt. Thus, Schmidt and Young, whether considered separately or on combination as proposed by the Office Action, fail to disclose or suggest all of the limitations of Claim 12. In light of these remarks, it is respectfully requested that the rejection of Claim 12 under 35 U.S.C. § 103(a) over Schmidt in view of Young be reconsidered and withdrawn. The Applicants respectfully request that Claim 12 be allowed.

Claims 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of Nichols. However, as discussed below, this rejection is respectfully traversed.

#### Claim 4

Claim 4 is dependent upon Claim 1. Accordingly, the remarks herein regarding Claim 1 apply equally to Claim 4. That is, Schmidt cannot render obvious Claim 4 at least for the same reasons that Schmidt cannot render obvious Claim 1. Nichols fails to cure the deficiencies of Schmidt. Thus, Schmidt and Nichols, whether considered separately or on combination as proposed by the Office Action, fail to disclose or suggest all of the limitations of Claim 4. In light of these remarks, it is respectfully requested that the rejection of Claim 4 under 35 U.S.C. § 103(a) over Schmidt in view of Nichols be reconsidered and withdrawn. The Applicants respectfully request that Claim 4 be allowed.

#### Claim 14

Claim 14 is dependent upon Claim 11. Accordingly, the remarks herein regarding Claim 11 apply equally to Claim 14. That is, Schmidt cannot render obvious Claim 14 at least for the same reasons that Schmidt cannot render obvious Claim 11. Nichols fails to cure the deficiencies of Schmidt. Thus, Schmidt and Nichols, whether considered separately or on combination as proposed by the Office Action, fail to disclose or suggest all of the limitations of Claim 14. In light of these remarks, it is respectfully requested that

the rejection of Claim 14 under 35 U.S.C. § 103(a) over Schmidt in view of Nichols be reconsidered and withdrawn. The Applicants respectfully request that Claim 14 be allowed.

Claims 10 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of Jensen.

#### Claim 10

Claim 10 is dependent upon Claim 1, and intervening claims. Accordingly, the remarks herein regarding Claim 1 apply equally to Claim 10. That is, Schmidt cannot render obvious Claim 10 at least for the same reasons that Schmidt cannot render obvious Claim 1. Jensen fails to cure the deficiencies of Schmidt. Thus, Schmidt and Jensen, whether considered separately or on combination as proposed by the Office Action, fail to disclose or suggest all of the limitations of Claim 10. In light of these remarks, it is respectfully requested that the rejection of Claim 10 under 35 U.S.C. § 103(a) over Schmidt in view of Jensen be reconsidered and withdrawn. The Applicants respectfully request that Claim 10 be allowed.

#### Claim 19

Claim 19 is dependent upon Claim 11, and intervening claims. Accordingly, the remarks herein regarding Claim 11 apply equally to Claim 19. That is, Schmidt cannot render obvious Claim 19 at least for the same reasons that Schmidt cannot render obvious Claim 11. Jensen fails to cure the deficiencies of Schmidt. Thus, Schmidt and Jensen, whether considered separately or on combination as proposed by the Office Action, fail to disclose or suggest all of the limitations of Claim 19. In light of these remarks, it is respectfully requested that the rejection of Claim 19 under 35 U.S.C. § 103(a) over Schmidt in view of Jensen be reconsidered and withdrawn. The Applicants respectfully request that Claim 19 be allowed.

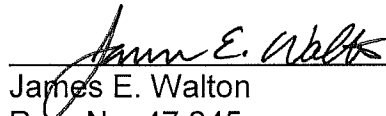
**CONCLUSION:**

The Applicants submit that the foregoing amendments and remarks place the subject application in condition for allowance. As such, the Applicants respectfully request reconsideration and a Notice of Allowance.

This Amendment is being filed via the U.S. Patent and Trademark Office's EFS-Web electronic filing system. No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to **Deposit Account No. 502806**.

Respectfully submitted,

6/21/10  
Date

  
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